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UNITED STATES DISTRICT COURT  
SOUTHERN DISTRICT OF CALIFORNIA

1 AMERANTH, INC.,

2 Plaintiff,

3 v.

4 PIZZA HUT, INC., ET AL.,

5 Defendants.

6 CASE NOS. 11-cv-1810 WQH (WVG),  
7 12-cv-742 WQH (WVG), 12-cv-739 WQH  
8 (WVG), 12-cv-737 WQH (WVG), 12-cv-  
9 733 WQH (WVG), 12-cv-732 WQH  
10 (WVG), 12-cv-731 WQH (WVG), 12-cv-  
11 729 WQH (WVG), 12-cv-858 WQH  
12 (WVG), 12-cv-1659 WQH (WVG), 12-cv-  
13 1656 WQH (WVG), 12-cv-1655, WQH  
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21 1642 WQH (WVG), 12-cv-1640 WQH  
22 (WVG), 12-cv-1636 WQH (WVG), 12-cv-  
23 1634 WQH (WVG), 12-cv-1633 WQH  
24 (WVG), 12-cv-1631 WQH (WVG), 12-cv-  
25 1630 WQH (WVG), 12-cv-1629 WQH  
26 (WVG), and 12-cv-1627 WQH (WVG)

27 **JOINT MOTION REGARDING**  
28 **SERVICE OF AMENDED**  
1 INFRINGEMENT CONTENTIONS  
2 [Doc. No. 432]

3 **ORAL ARGUMENT REQUESTED BY**  
4 **PLAINTIFF]**

5 AND RELATED CASES.

6 ///

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## *AMERANTH'S POSITION*

## **AMERANTH'S PROPOSED SCHEDULE**

The purpose of this Joint Motion is to address certain questions raised in Judge Stormes' July 26, 2013 Order regarding the infringement contentions ("IC's) Ameranth served on defendants OpenTable, Wanderspot and Best Western [Doc. No. 432]. The Court asked the parties to submit proposals regarding a schedule for Ameranth to serve amended ICs on those three defendants, and to address what other ICs, if any, should be amended and what scheduling order dates, if any, should be modified. [Doc. No. 432, p. 15]

Ameranth proposes that no substantive changes be made to the current case management schedule [Doc. Nos. 345, 346]. Instead, Ameranth proposes that, for the defendants who timely raised with Ameranth objections to Ameranth’s ICs that correspond to one or more of the four items identified in Judge Stormes’ July 26, 2013 Order [Doc. No. 432], Ameranth serve amended ICs meeting the standards articulated in the Order by November 21, 2013, the date on which any amendments to the ICs are currently due under the Court’s Scheduling Order [Doc. No. 346, ¶¶7] and Patent Local Rule (“PLR”) 3.6a<sup>1</sup>.

Ameranth's proposal: (1) best comports with the policy of bringing the cases to claim construction and trial within a reasonable period of time (see PLR 2.1(a)); (2) avoids the wasteful measure of requiring production of "intermediary" ICs prior to the time that defendants produce technical materials and source code in response to Ameranth's discovery requests and PLR 3.4a (under the existing case management schedule, defendants' PLR 3.4a productions are due on September 6, 2013, and Ameranth has until November

<sup>1</sup> Ameranth's proposal is not a concession that the four issues raised in the Court's July 26, 2013 Order necessarily apply to the ICs for any of the defendants other than moving parties Wanderspot, Best Western or OpenTable. Ameranth believes that many of the ICs sufficiently fulfill the requirements of PLR 3.1 contentions.

1 21, 2013, to serve amended ICs); and (3) preserves Ameranth's right under PLR  
2 3.6a and the Court's scheduling orders to serve amended ICs.

In contrast with Ameranth’s proposal, which maintains the Court’s existing scheduling order, the defendants seek to further delay the case-- contrary to the policy of PLR 2.1(a) and without sufficient good cause as required by Fed. R. Civ. Proc. 16(b)(4)—by seeking to delay their PLR 3.4(a) productions and to “stay” Ameranth’s discovery efforts. Defendants also seek to require Ameranth to wastefully produce an “intermediary” set of infringement contentions for over 30 defendants within an incredibly short period of time at significant expense, while concurrently depriving Ameranth of the discovery to which it is entitled. Defendants do so in order to create a “Catch-22” situation for Ameranth, in which Judge Stormes’ newly articulated “reverse engineering” standard cannot reasonably be met because the defendants retain sole possession of the source code and technical materials necessary to meet such a standard.

15 Importantly, Ameranth’s ability to produce amended ICs within the  
16 November 21 time frame set forth in the existing case management schedule *is*  
17 *dependent upon the defendants honoring their obligations to comply with*  
18 *Ameranth’s discovery requests and to fulfill their requirements under PLR 3.4a.*  
19 As discussed herein, the defendants’ accused systems and instrumentalities are  
20 primarily *non*-publicly available software systems running in secure data  
21 centers. Unlike the accused instrumentalities at issue in the typical patent case,  
22 most aspects of the systems accused in this case (other than publicly facing  
23 webpages and phone “apps”) can be obtained and analyzed *only* through the  
24 discovery and disclosure process. Therefore, in order to comply with the  
25 standard of IC specificity articulated by Judge Stormes in the July 26, 2013  
26 Order (“an accusing party must provide the level of detail required to meet the  
27 ‘reverse engineering or its equivalent’ standard. ... To comply with this

1 standard, the asserting party must explain its theory of how the product infringes  
 2 the claim element” [Doc. No. 432, p. 13], the defendants *must* be required to  
 3 promptly and completely respond to Ameranth’s discovery requests, to fully  
 4 complete their “rolling productions” of documents in response to Ameranth’s  
 5 requests for production (see Doc. No. 422), and to make the productions of  
 6 technical documents and source code required by PLR 3.4a and section 5a of the  
 7 Scheduling Order [Doc. 346, ¶5a], along with the tools necessary to effectively  
 8 review such code.

9 To date, productions of source code and PLR 3.4a technical documents  
 10 have been made only by the “original” defendants (Pizza Hut, QuikOrder, Papa  
 11 John’s, Domino’s, Seamless, GrubHub, OpenTable and OWeb) in connection  
 12 with the infringement claims asserted in the earlier filed lawsuits, as  
 13 supplemented since. All other defendants are scheduled to make their PLR  
 14 3.4(a) source code and technical material productions on September 6, 2013.  
 15 Even in connection with the original defendants that have produced source code,  
 16 Ameranth only recently procured their agreement to install on the review laptops  
 17 the software tools necessary to review the code in its native format, as required  
 18 by the Court’s February 20, 2013 Order [Doc. No. 342]. Consequently, because  
 19 of the proprietary and non-public nature of the accused systems, defendants  
 20 must fully respond to Ameranth’s outstanding discovery requests, timely  
 21 complete their “rolling productions” of documents responsive to Ameranth’s  
 22 requests for production (as ordered by the Court [Doc. No. 422]), and to make  
 23 complete productions of source code and PLR 3.4a technical documents on the  
 24 schedule set forth in the Court’s Scheduling Order so that Ameranth can produce  
 25 amended ICs by November 21, 2013 complying with the Judge Stormes’  
 26 specificity standard and without damaging the case management schedule.  
 27

1       Alternatively, if the Court will not require the defendants to respond to  
2 Ameranth's discovery requests, to produce source code and to comply with the  
3 PLR 3.4a production requirements prior to the date by which Ameranth will  
4 serve amended ICs, Ameranth requests the Court to articulate a different  
5 standard of specificity and disclosure applicable to the defendants who have not  
6 made such productions and disclosures, as described herein.

## DISCUSSION

**A. A “Reverse Engineering” Specificity Standard Requires Access To The Accused Infringer’s Technical Information.**

In Zest IP Holdings, LLC v. Implant Direct Mfg, LLC, 2013 WL 1626111 (S.D. Cal. April 15, 2013)[Dkt. No. 216], the Hon. Gonzalo P. Curiel of this District interpreted and defined the requirements imposed by PLR 3.1 regarding ICs. The defendants in Zest, like those in this case, contended that the plaintiff's ICs failed "with sufficient specificity to provide Defendants with adequate notice [of the claim of infringement]" and "fail to explain how each element of the claim is present in the [accused] product." Id. at \*5. The District Court rejected the defendants' "how," argument, holding that "Rule 3-1 does not require the patent holder to produce evidence of infringement, but it must map specific elements of Defendants' alleged infringing products onto the Plaintiff's claim construction." Id. The Court therefore concluded:

20 Here, the Plaintiffs' infringement charts contain both specific  
21 and illustrative examples of the Defendants' infringement of the  
22 asserted claims, and identify each specific element as to which  
23 the Plaintiffs have a claim. ECF No. 107, Exhibit 10 at 2. The  
24 amended infringement contention maps out these claims for  
25 each element. As such, the Court finds that the amended  
26 infringement contention contains sufficient information to put  
27 Defendants on notice as to each claim. Accordingly, the Court  
finds that Plaintiffs have stated with sufficient particularity the  
manner in which the new product infringes the patent, thereby  
satisfying Local Rule 3.1.

1       Id<sup>2</sup>. See also Anticancer, Inc. v. Cambridge Research, Case No. 07-cv-0097  
2 (S.D. Cal., May 14, 2008)(J. Sammartino) [Doc. 49] (“Besides the requirement  
3 of evidence sufficient to create a triable question of fact on infringement, the law  
4 does not require that the PICs contain a particular level of detail or be worded in  
5 a particular way.” Id. at 12); Anticancer, Inc. v. Pfizer, Inc., Case No. 11-cv-  
6 107 (S.D. Cal. 2012)(J. Sammartino)[Doc. No. 63] (“the Court believes that the  
7 appropriate balance requires that the PICs contain ‘sufficient specificity to  
8 provide defendants with notice of infringement beyond that which is provided  
9 by the mere language of the patents themselves,’ but need not be so detailed as  
10 to transform the PICS into a ‘forum for litigation of the substantive issues’”).

In contrast to the interpretation of PLR 3.1 adopted by Judge Curiel in Zest rejecting the argument that ICs must demonstrate “how” an accused instrumentality infringes asserted patent claims, Judge Stormes held that Ameranth “must identify with specificity where in the accused system the alleged infringement occurs and how the claim elements are met,” and must “meet the ‘reverse engineering or its equivalent’ standard.” [Doc. No. 432]

17 The cases relied upon by Judge Stormes for the “reverse engineering”  
18 standard involved markedly different type of accused instrumentalities than  
19 those at issue here. In Intertrust Tech. Corp. v. Microsoft, 2003 WL 23120174  
20 (N.D. Cal 2003), the accused product was a security module in Microsoft’s  
21 publically available software (e.g., Windows) that could be commercially  
22 purchased by the plaintiff and “reverse engineered” by its experts. Likewise, in

<sup>23</sup> Judge Curiel's interpretation of the PLRs in Zest is consistent with the  
<sup>24</sup> interpretation applied by Judge Sammartino in her March 26, 2013 Order  
<sup>25</sup> denying Papa John's motion for summary judgment in this case, in which only  
<sup>26</sup> the *existence* of claim elements in the accused systems were required to be  
<sup>27</sup> identified, and not an explanation of "how" the accused system practiced the  
<sup>28</sup> patents' claims. See Doc. No. 55, p. 12 ("the Court finds that the Amended  
PICs set forth with sufficient specificity that Papa John's practiced this element  
[the central database]. Ameranth has used publicly available information,  
including excerpts of Papa John's web pages and promotional materials, to point  
to the *existence* of a central database"). Emphasis added.

1     GN Resound A/S v. Callpod, Inc., 2013 WL 1190651 (N.D. Cal. 2013), the  
2     product accused of infringement was a commercially available sound filtering  
3     headset that could be purchased, disassembled, and reverse engineered.  
4     Similarly, Tessendro Kerley, Inc. v. OR-Cal, Inc., 2012 WL 1253178 (N.D. Cal.  
5     2012), involved a publically available sun protectant chemical for crops that  
6     could be purchased by the plaintiff and analyzed in a laboratory.

7 As this Court has recognized, “patent local rules generally anticipate that,  
8 where feasible, the patentee already has purchased samples of the allegedly  
9 infringing product and analyzed them *prior to* filing suit.” Nesscap Co., Ltd. v.  
10 Maxwell Tech., Inc., 2008 WL 152147, \*3 (S.D. Cal. 2008). Where the  
11 defendants’ accused products/systems are *not* publically available, however,  
12 discovery and the defendant’s disclosure obligations under PLR 3.4 are *required*  
13 to procure the information “which the plaintiff could not obtain before initiating  
14 the litigation.” Id.

15 The defendants' accused systems here are completely different types of  
16 creatures than those described in the cases from which Judge Stormes drew the  
17 reverse engineering standard of specificity. The accused systems in this case are  
18 large scale enterprise level proprietary software systems. As this Court noted in  
19 its February 20, 2013 Order, citing defendants' expert:

20 The e-commerce systems at issue here are complex and involve  
21 different types of source code, computer language, hardware  
22 systems, operating systems, third party interfaces, applications  
23 and data under third parties' control. ... The e-commerce  
24 systems identified in the complaints combine proprietary  
software and data and third party software and data .... [Doc.  
No. 342, p. 9]

Likewise, because of the confidential and non-public nature of the defendants' systems, the Court has issued a restrictive Protective Order for such

material. [Doc. No. 323, ¶ 9] The only “publically accessible” portions of the defendants’ accused software systems that Ameranth has access to without discovery and disclosure from the defendants are the “consumer accessible” portions of the systems manifested on public webpages, phone apps, etc. (to which Ameranth has cited in its ICs). But those are the figurative “tip of the iceberg” for these systems. Much of the heavy lifting—and much of the infringing functionality—is located and operates in the *non*-public back-end of the software systems, on secure computer servers, in proprietary databases, in confidential source code, etc., to which Ameranth has no access beyond what is produced in discovery. Under such circumstances, courts recognize and acknowledge a patent infringement plaintiff’s right to obtain the defendants’ source code and technical materials.

13           The Northern District of California has recognized that, where  
14 information about the manner in which an accused system resides in software  
15 which is exclusively in the defendants' possession, a plaintiff's ICs cannot be  
16 held to a reverse engineering standard and the plaintiff should not be required to  
17 identify specifically where each element of each claim is found *beyond stating*  
18 *that it resides in the relevant software.* See CSR Technology, Inc. v. Freescale  
19 Semiconductor, 2013 WL 503077, \*6-7 (N.D. Cal. 2013) ("As with the previous  
20 limitation, Plaintiff contends that certain of the accused features and  
21 functionalities of this limitation reside in software .... Because Plaintiff's ICs  
22 identify the limitations of the '886 patent as residing in specific software—  
23 which is exclusively in Defendant's possession—the Court finds that Plaintiff's  
24 ICs are sufficient for purposes of Rule 3-1(c)"). See also Apple v. Samsung,  
25 2013 WL 3246094, \*3 (N.D. Cal. 2013) ("Parties accordingly need not "prove  
26 up" their theories by providing evidence beyond the material they have at the  
27 time they make their contentions"); France Telecom, SA v. Marvell

1 Semiconductor, Inc., 2013 WL 1878912, \*4 (N.D. Cal. 2013)(when defendant is  
2 in sole possession of information about the accused system, plaintiff satisfies  
3 PLR 3.1 by “disclosure of the factual basis for its allegations” with the  
4 information currently available to it”)(citations omitted). In distinguishing  
5 Network Caching Tech. LLC v. Novell, Inc., 2002 WL 32126128 (N.D. Cal.  
6 2002), the CSR v. Freescale decision explicitly recognized that the reverse  
7 engineering standard is not applicable to software limitations as to which the  
8 accused software has not been produced:

Without analysis, Defendant cites to Network Caching Tech. LLC v. Novell Inc. In Network Caching, the court held that while reverse engineering was required to meet plaintiff's obligations under Federal Rule of Civil Procedure 11 for non-software limitations, under Rule 3-1(c), the "routines" in the software that carry out the claimed function do not need to be specifically identified because "[t]he only way to pinpoint the specific routine is to analyze the source code, which is solely in the defendants' possession."

<sup>15</sup> CSR v. Freescale, 2013 WL 503077, at \*6-7 (citations omitted).

16 This practice has also been recognized and adopted in the Eastern  
17 District of Texas. For example, several of the judges there have adopted forms  
18 of discovery orders that provide:

P.R. 3-1(g): If a party claiming patent infringement asserts that a claim element is a software limitation, the party need not comply with P.R. 3-1 for those claim elements until 30 days after source code for each Accused Instrumentality is produced by the opposing party. Thereafter, the party claiming patent infringement shall identify, on an element-by-element basis for each asserted claim, what source code of each Accused Instrumentality allegedly satisfies the software limitations of the asserted claim elements.

See Exh. 1 (Discovery Order for Patent Cases); Exh. 2 (Appendix).

As stated in American Video Graphics, L.P. v. Electronic Arts, Inc., 359 F.Supp. 2d 558 (E.D. Tex. 2005):

1  
2 In non-software patent cases, plaintiffs are usually able to  
3 purchase defendants' products and ascertain the mechanics of  
4 how those products infringe before plaintiffs bring suit. But,  
5 there are times when plaintiffs' preparation is restricted by  
6 defendants' sole possession of the information plaintiffs need.  
7 Software cases present unique challenges for the parties and the  
8 courts because, prior to discovery, plaintiffs usually only have  
9 access to the manifestation of the defendants' allegedly  
10 infringing source code and not the code itself. From this  
11 manifestation, plaintiffs must somehow divine whether the  
12 defendants' code infringes. Although defendants vigorously  
13 and rightly guard their source code, until plaintiffs have access  
14 to it, plaintiffs are typically unable to give highly specified  
15 infringement contentions.

16 See also Prism Technologies v. Research in Motion, Ltd., 2010 WL 1254940,  
17 \*3 (D. Neb. 2010).

18 Of the three moving parties directly subject to the Court's July 26, 2013  
19 Order [Doc. No. 432], OpenTable, Wanderspot and Best Western, only  
20 OpenTable—one of the original defendants—made a production of source code  
21 and PLR 3.4a materials (in the earlier phase of the proceedings). Ameranth was  
22 therefore able to include non-public source code citation in its ICs for  
23 OpenTable<sup>3</sup>, but not for Wanderspot or Best Western (or any of the defendants  
24 that have not yet made PLR 3.4 productions). (Defendants falsely represent to  
25 the Court that Ameranth's ICs do not cite to any of the "publicly available"  
26 source code from defendants' websites. That is demonstrably untrue. For  
27 example, Exhibits 47 and 48 to the OpenTable ICs, and Exhibit 57 to the Best  
28 Western ICs, comprise source code from the defendants' websites. Judge

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1 Stormes may not have appreciated this because the claim charts themselves do  
 2 not explicitly state that those exhibits contain source code.)

3 Judge Stormes' Order, however, does not set a differential IC standard  
 4 for a defendant that has produced source code and PLR 3.4a materials (like  
 5 OpenTable), on one hand, and those that have not done so (such as Wanderspot,  
 6 Best Western and the other non-original defendants). Instead, the Order  
 7 articulates a single "reverse engineering or its equivalent" standard, apparently  
 8 uniformly requiring Ameranth to "identify with specificity where in the accused  
 9 systems the alleged infringement occurs and how the claim elements are met"  
 10 [Doc. No. 432, p. 14], even where such elements are located in source code and  
 11 non-public PLR 3.4a materials that have not yet been produced to Ameranth.  
 12 The logical consequence of the Order is that the defendants *must* be required to  
 13 make their PLR 3.4a productions *before* Ameranth is required to serve amended  
 14 ICs conforming to this specificity standard.

15 Ameranth is prepared to undertake this task and to produce amended ICs  
 16 conforming to Judge Stormes' standard if required by the Court. Ameranth also  
 17 believes that it can accomplish this by the date currently scheduled for service  
 18 of amended ICs—November 21, 2013—and thereby *not* require any substantive  
 19 alteration of the Court's case management schedule. However, as explained  
 20 above, because of the confidential, proprietary and non-publicly accessible  
 21 nature of the defendants' accused software systems, and the fact that none of  
 22 the "non-original" defendants have made productions of source code or PLR  
 23 3.4a materials, in order to conform the amended ICs to this standard the  
 24 *defendants must be required to promptly, fully and meaningfully respond to*  
 25 *Ameranth's discovery, produce the materials requested in discovery, make their*  
 26 *source code available for inspection on review computers containing the*

27

1 appropriate native development tools, and make their PLR 3.4a productions as  
2 currently scheduled on September 6, 2013 [see Doc. No. 345, ¶ 4F].

3 Furthermore, it would be inefficient, time consuming, expensive and  
4 wasteful to require Ameranth to produce *two* sets of amended ICs—(1)  
5 “intermediary” amended IC’s produced without benefit of the defendants’  
6 discovery responses and PLR 3.4(a) productions of source code and technical  
7 materials, and (2) second amended ICs served after production of such  
8 materials. The defendants have sufficient information about what their accused  
9 systems are to make productions of responsive documents, materials and source  
10 code, and should be required to do so as presently scheduled.

**B. Ameranth Has Timely Sought Discovery of the Materials Required to Produce ICs Meeting the Court’s Articulated Specificity Standard, and the Defendants Must Be Required to Produce and Provide Such Materials**

14 Ameranth has been diligent in its efforts to obtain discovery about the  
15 non-publically available aspects of the defendants' confidential software  
16 systems. Because of the provisions of the Court's orders and PLRs regarding  
17 source code, production and inspection of source code has awaited the  
18 defendants' PLR 3.4a productions scheduled for September 6, 2013.

Ameranth served comprehensive RFPs on the defendants in February of 2013 seeking information about the accused systems relevant to an infringement analysis and in a time frame that would have allowed Ameranth to have the benefit of the responsive information at the time it served its initial ICs on the defendants. Judge Stormes “stayed” that discovery, but deemed it re-served on April 1, 2013. [Doc. 345, ¶ 4G]. Thus, despite the fact that the Scheduling Order does not require defendants to make their PLR 3.4a productions prior to September 6, 2013, the Court specifically allowed Ameranth to proceed with discovery into defendants’ accused systems. This is,

1 of course, consistent with PLR 2.5, which allows discovery into the basis of  
 2 infringement to proceed *prior* to the time that a defendant is required to make  
 3 its formal PLR 3.4a production.

4        Ameranth has served additional RFPs and other discovery upon the  
 5 defendants since then attempting to procure relevant and non-publically  
 6 available information, some of which is further described below. Despite the  
 7 fact that the multiple discovery requests have been outstanding for weeks and  
 8 months, defendants have consistently asserted an inability to make prompt  
 9 comprehensive productions, and instead requested to make productions on a  
 10 “rolling basis.” Ameranth agreed to this accommodation, and the Court  
 11 adopted it in a July 15, 2013 Order [Doc. No. 422], under which the defendants  
 12 are to “complete their rolling production of non-privileged documents  
 13 responsive to Ameranth’s Requests for Production” by September 6, 2013.  
 14 However, despite the fact that the Order instructs the defendants *not* to wait  
 15 until the deadline, but instead to make productions “promptly as responsive  
 16 documents are located,” defendants productions to date have been spotty at  
 17 best. Thus, Ameranth has not yet obtained the full scope of defendants’ non-  
 18 publically available materials about their software systems necessary for  
 19 Ameranth to produce “reverse engineering” level ICs, despite the fact that it has  
 20 diligently engaged in discovery to obtain such information.

21        In addition to the multiple sets of RFPs propounded by Ameranth to the  
 22 defendants, Ameranth served interrogatories seeking information about the  
 23 organization of the source code and databases for each of their accused systems.  
 24 While a few defendants provided substantive responses, most objected to the  
 25 interrogatories and instead invoked Fed. R. Civ. Proc. 33(d), telling Ameranth  
 26 to “figure it out itself” from their source code. One of the ironies of such  
 27 responses, of course, is that none of the “new defendants” have yet produced

1 their source code for inspection. They are withholding that apparently for their  
 2 PLR 3.4(a) productions, currently due on September 6. Moreover, even for the  
 3 original defendants that have produced source code, invocation of Fed. R. Civ.  
 4 Proc. 33(d) is not proper because the burden of deriving the requested  
 5 information is not the same for Ameranth (which is only receiving portions of  
 6 the defendants' source code on isolated review computers, is not seeing the  
 7 entire source code tree, and obviously does not have the kind of familiarity with  
 8 each defendant's system that the defendants' IT employees have<sup>4</sup>). Ameranth  
 9 has brought a joint discovery motion with defendant QuikOrder raising these  
 10 issues, currently pending before the Court. [Doc No.450]. The subject of those  
 11 "source code organization" interrogatories, however, is relevant to all of the  
 12 defendants who have failed to provide substantive responses, and particularly to  
 13 those as to which Ameranth is to serve amended ICs following Judge Stormes'  
 14 July 26, 2013 Order.

15 Those interrogatories, for example, ask the defendants to identify all  
 16 source code projects in their systems corresponding to types of functionality  
 17 relevant to Ameranth's infringement claims. They ask the defendants to  
 18 identify the specific location in their systems (*i.e.*, directory, folder, file, *etc.*)  
 19 for each relevant source code project. They ask for identification of all  
 20 databases used with the defendants' systems. They ask for identification, by  
 21 number and dates of use, of all versions of the defendants' accused systems.  
 22 All of these are topics on which Ameranth is entitled to do discovery and, in  
 23 light of the July 26, 2013 Order articulating a "reverse engineering" standard  
 24 and requiring more precise identification of accused versions of the systems, the  
 25 information is necessary for Ameranth to amend its ICs to meet this standard.

26  
 27 <sup>4</sup> Pursuant to Judge Stormes' February 20, 2013 Order [Doc. No. 342],  
 28 defendants were not required to produce their full source code trees in an  
 operational environment, but only portions of the code.

1 The interrogatories are designed, among other things, to provide Ameranth's  
2 source code review consultants with a structural understanding of the  
3 organization of the defendants' systems in order to enable them to efficiently  
4 analyze the code and determine completeness of the defendants' productions.  
5 To enable efficient review of the source code, and adherence to the proposed  
6 schedule for amending the ICs, the defendants must be required to promptly  
7 provide this information.

Ameranth also has insisted that the defendants produce their source code on review computers containing the software review and development tools corresponding to the programming language(s) in which the code was written so that Ameranth’s consultants can review the code in its native format, as required by the Court’s February 20, 2013 Order [Doc. No. 342, p. 12].

Although, after a lengthy meet and confer process, the original defendants who have produced source code eventually agreed to install appropriate tools on the review computers, not all of the new defendants have agreed to do so. They should be required to install such tools on the review computers in order to permit meaningful and efficient review of their source code and thereby enable Ameranth to produce amended ICs conforming to Judge Stormes’ standard if that standard is to be employed in this case.

20 Ameranth has likewise noticed various site inspections of facilities (such  
21 as hotels and restaurants) in which several of the defendants' systems are  
22 installed in order to inspect some of the "behind the counter" and non-public  
23 operations of such systems. Ameranth has also noticed depositions of certain  
24 IT officers of some of the defendants. All of this discovery should be permitted  
25 to go forward without interference or delay from the defendants to enable  
26 Ameranth to comply with the July 26 Order and complete the update of its ICs  
27 by November 21, 2013.

1        Most importantly, defendants must be required to proceed with their  
2 complete PLR 3.4a productions of source code and technical documents on  
3 September 6, 2013 as required by the Case Management Order [Doc. No. 345,  
4 ¶4F]. Because of the non-public nature of the defendants' software systems,  
5 information about those systems necessary to produce amended ICs meeting  
6 Judge Stormes' standard must be derived from the defendants' PLR 3.4a  
7 technical documents and source code. See Nesscap Co., Ltd. v. Maxwell Tech.,  
8 Inc., 2008 WL 152147 (S.D. Cal 2008) ("The Court reads Patent Local Rule  
9 3.4(a) as requiring the responding party to provide the raw data (source code,  
10 schematics, formulas, etc.) sufficient to show the operation of the accused  
11 aspects of the products in order to allow the patentee to make *its own*  
12 determinations as to infringement. See McKesson, 495 F.Supp.2d at 1334  
13 (construing the rule as imposing a good faith obligation to 'provide the types of  
14 information that will enable *the party* asserting infringement to reasonably  
15 determine the operation of the accused device or method without undue burden  
16 or expense')").

Under the defendants' proposed schedule, the defendants would *not* be required to produce their PLR 3.4a technical materials and source code or complete their "rolling productions" of documents until *after* Ameranth has served amended ICs. That position is not viable, or fair, for several reasons:

21       1. As discussed above, in order to produce ICs meeting Judge  
22 Stormes' standard, source code and technical materials for the defendants'  
23 systems *must* be provided to Ameranth with sufficient time for it to be reviewed  
24 and analyzed.

25        2. The Court's case management and scheduling Orders [Doc. Nos.  
26 345, 346] expressly allowed Ameranth to proceed with discovery into the  
27 accused systems prior to the initial dates for service of ICs on the defendants.

3. PLR 2.5 expressly permits a party (with non-relevant exceptions) to proceed with discovery and obtain disclosures regardless of any objection that it is premature in light of other requirements imposed by the PLRs.

4. The Court's Orders, and the PLRs, permit Ameranth to serve amended ICs after the date on which defendants are required to make their PLR 3.4(a) productions to Ameranth (in this case, up until November 21, 2103).

5. Defendants have admitted, in discovery responses, meet and confer discussions, by invocation of Rule 33(d) in response to interrogatories about their systems, and in joint motions to permit rolling productions of documents in response to Ameranth's RFPs [see, e.g., Doc. Nos. 420, 422], that they understand the scope of their accused systems sufficiently to make productions of responsive documents. They have *not* sought protective orders.

6. Discovery in patent actions is not restrictively confined only to items specifically described in ICs. See, e.g., Dr. Systems v. Fujifilm Medical Systems USA, Inc., 70 Fed.R. Serv. 3d 348, 2008 WL 1734241 \*3 (S.D. Cal. 2008)(J. Stormes); Gen-Probe Inc. v. Becton, Dickinson and Co., 2010 WL 2011526 \*3 (S.D. Cal. 2010); WebSideStory, Inc. v. NetRatings, Inc., 2007 WL 1109597 \*2 (S.D. Cal. 2007); DDR Holdings, LLC v. Hotels.com, L.P., 2012 WL 2935172 \*2 (E.D. Tex 2012).

Defendants mistakenly cite to Implicit Networks v. Hewlett-Packard Co., 2011 WL 3954809 (N.D. Cal. 2011), and Infineon Techs. v. Volterra Semiconductor, 2012 WL 4808445 (N.D. Cal. 2012), both from the Northern District of California, for the proposition that defendants should be excused from complying with their outstanding discovery and PLR 3.4a obligations until after Ameranth serves amended ICs. Because those cases are materially different and distinguishable from this matter, defendants' argument is unpersuasive.

1       The accused instrumentalities in both Implicit Networks and Infineon  
 2 were commercially available products that the plaintiff could purchase and  
 3 reverse engineer independent of resort to discovery. Implicit Networks  
 4 involved certain HP network switches, routers and webservers (2011 WL  
 5 3954809 at \* 1), and Infineon dealt with metal conductors contained in  
 6 semiconductors (2012 WL 4808445 at \*2-3). As discussed at length herein,  
 7 those types of publicly available products are recognized by courts to be subject  
 8 to *different* treatment with respect to IC standards and the plaintiffs' need for  
 9 discovery than non-public software systems, such as the defendants' systems  
 10 accused of infringement here.

11       In fact, the Implicit Networks decision explicitly based its ruling on the  
 12 publicly available nature of the accused HP products, such that the plaintiff  
 13 should be able reverse engineer the products without aid of discovery. As the  
 14 Implicit Networks court stated: “the Court finds that HP's position—that the  
 15 WSS product is free and available—is sufficient to require Implicit to reverse  
 16 engineer the WSS product itself, not the open source code it is allegedly based  
 17 on. *If it turns out that the actual source code for the WSS product is not readily*  
 18 *available to Implicit for its analysis, the Court ORDERS that it be provided to*  
 19 *Implicit immediately and that the due date for Implicit's revised infringement*  
 20 *contentions for the Application Server Patents is extended by the number of*  
 21 *days it takes for Implicit to secure a copy of the WSS code for its reverse*  
 22 *engineering analysis.*” 2011 WL 3954809 at \*3, n. 5 (emphasis added). Thus,  
 23 Implicit Networks actually support Ameranth's position that it should not be  
 24 required to amend the ICs until *after* the defendants have completed their  
 25 discovery and PLR 3.4a productions.

26       Moreover, defendants' request for a discovery stay ignores the facts that:  
 27 (1) PLR 2.5 provides that discovery and disclosures (such as PLR 3.4a) shall

1 proceed regardless of an objection that they are premature in light of other  
2 provisions of the PLRs (such as PLR 3.1); (2) the Court’s case management and  
3 scheduling orders in this case [Doc. Nos. 345, 346] specifically: (a) permitted  
4 Ameranth to proceed with discovery into defendants’ accused systems prior to  
5 the dates on which ICs were due to be served; and (c) required the defendants to  
6 make their PLR 3.4 disclosures and productions prior to the date by which  
7 Ameranth had to serve amended ICs; and (3) the defendants already agreed  
8 (and represented they could), and the Court ordered, that defendants complete  
9 their “rolling productions” of documents responsive to Ameranth’s RFPs by  
10 September 6 [Doc. Nos. 420, 422]. Thus, there is no good faith reason for  
11 defendants to not produce the materials about their accused systems that  
12 Ameranth can obtain only through discovery and which are necessary to amend  
13 the ICs to Judge Stormes’ articulated standard of specificity.

14 For these reasons, in order to permit Ameranth to produce amended ICs  
15 conforming to Judge Stormes' standard of specificity, the defendants should be  
16 required to timely comply with outstanding discovery and to make complete  
17 PLR 3.4a productions by September 6<sup>5</sup>. Specifically, Ameranth requests that  
18 defendants be required to:

19       1. Fully complete their “rolling productions” of all non-privileged  
20 documents responsive to Ameranth’s outstanding RFPs by no later than  
21 September 6, 2013 [Doc. No. 422];

22        2. Fully comply with Ameranth's outstanding site inspection requests  
23 and deposition notices/ subpoenas;

<sup>5</sup> Any argument that the defendants cannot make Invalidity Contentions until after they receive amended ICs is belied by the fact that, in the early phase of this litigation, the original defendants already served a lengthy set of invalidity contentions and supporting references for the patents-in-suit at that time, all of which are in the same patent family.

1           3. Produce all relevant source code for their accused systems by no  
2 later than September 6, 2013, on review computers installed with all software  
3 development and review tools necessary to view the code in its native format;

4        4. Produce all other PLR 3.4(a) technical documents and materials  
5 regarding their accused systems by September 6, 2013 [Doc. No. 345]; and

6       5. Provide responsive narrative answers to Ameranth's interrogatories  
7 re Source Code Organization [see Doc No. 450].

If defendants fulfill these obligations promptly, completely and in good faith, Ameranth believes it in turn can serve amended ICs conforming to the July 26 Order by the date by which Ameranth is currently to serve any amended ICs—November 21, 2013. That would permit the Court to maintain the case management schedule and not cause delays. However, if the defendants fail to fully and promptly comply with these discovery and disclosure obligations, it is likely that the date for serving amended ICs, and other case management dates, would need to be continued.

If the Court will not require the defendants to comply with Ameranth's discovery requests or make their PLR 3.4a productions prior to the date on which Ameranth serves amended ICs on such defendants, then the Court should adopt a different standard of IC specificity, because Ameranth obviously cannot provide "reverse engineering" level ICs for the defendants' non-public software systems without meaningful access to their technical materials and source code. Under such circumstances, Ameranth suggests that the Court utilize a standard similar to that described in CSR Technology, Inc. v. Freescale Semiconductor, 2013 WL 503077 (N.D. Cal. 2013), and in the Eastern District of Texas (see Exhs. 1, 2), under which Ameranth's ICs would identify when elements of the patent claims are located in software in the defendants' possession.

1           C. **Ameranth's Proposal Should Be Adopted By The Court**  
 2           **Because It Best Preserves the Existing Case Management**  
 3           **Schedule, Is Consistent With the Parties' Legal**  
 4           **Obligations And Is Most Realistic And Fair**

5 Ameranth's proposal is superior to the defendants' because it requires no  
 6 modification to the Court's existing case management schedule and is most  
 7 consistent with the parties' existing rights and obligations regarding the time in  
 8 which to serve amended ICs, the time by which to make PLR 3.4(a)  
 9 productions, and the time by which to complete rolling productions and respond  
 10 to outstanding discovery. Ameranth's proposal provides a means to keep this  
 11 case on track for claim construction and eventual trial, while adhering to Judge  
 12 Stormes' recent ruling. Ameranth's schedule also realistically reflects the time  
 13 fairly required to meaningfully amend numerous sets of lengthy ICs (most of  
 14 the ICs, inclusive of exhibits, comprise hundreds of pages).

15 The defendants' proposal would, in contrast, create delays and require an  
 16 expensive and wasteful set of intermediary ICs. Furthermore, defendants'  
 17 proposal that Ameranth be required to produce over 30 sets of lengthy amended  
 18 IC's by September 16, 2013 (a month *earlier* than the date by which Ameranth  
 19 may amend its ICs under the Court's Scheduling Order [Doc. No. 346])—  
 20 including for parties that have not made source code and technical document  
 21 productions—is unrealistic and not made in good faith. This is particularly the  
 22 case where, until the Court clarifies whether or not the “reverse engineering”  
 23 and “how” standard applies to defendants who have not yet produced source  
 24 code and technical materials, Ameranth cannot determine what standard the  
 25 amended ICs must meet. Defendants' proposal would require Ameranth,  
 26 without benefit of the defendants' discovery or PLR 3.4a materials, to create  
 27 over 30 sets of amended ICs in a 30 day period, presumably only to have to

1 amend them again, later, when the defendants finally provide their discovery  
 2 and PLR 3.4a productions. Such a proposal is neither fair nor efficient.

3 Defendants are transparently attempting to trap Ameranth into having to  
 4 produce a great number of ICs in an unrealistically short time while  
 5 simultaneously withholding from Ameranth the very materials Ameranth needs  
 6 to amend the ICs to Judge Stormes' new standard. It is noteworthy that the  
 7 Court's Case Management Order [Doc. No. 345, ¶4e] spread the schedule for  
 8 producing the original ICs for the more than 30 defendants over a 13 week  
 9 period, divided into 8 distinct groups. Defendants' cynical and unrealistic  
 10 proposal to require Ameranth to redo those by September 16 should be rejected.

11 Under Fed. R. Civ. Proc. 16(b)(4), scheduling orders should not be  
 12 modified without good cause. So long as the defendants timely comply with  
 13 their current discovery and PLR 3.4(a) obligations, the parties should be able to  
 14 maintain the current schedule.

15 **D. Ameranth Should Not Be Required To Amend Its ICs**  
**For the Defendants Who Did Not Timely Challenge The**  
**ICs Within the Court's 45 Day Deadline Or Obtain An**  
**Extension For Such Challenge**

16 Finally, the Court asked the parties to address the question of which of  
 17 the defendants Ameranth should be required to serve with amended ICs in light  
 18 of the July 26, 2013 Order. Ameranth's position is that, in addition to the  
 19 defendants who participated or joined in the motion (OpenTable, Wanderspot  
 20 and Best Western), Ameranth should serve amended ICs on all of the  
 21 defendants that timely produce source code, discovery and PLR 3.4a materials,  
 22 *except for* the seven "original" defendants that failed to file or join in a timely  
 23 motion contesting the sufficiency of the ICs served upon them or to obtain an  
 24 extension of time to do so (this limited group consists of Pizza Hut, QuikOrder,  
 25 Seamless, Domino's, OWeb, Papa John's and GrubHub).

1 It is important to note that, thus far, *only four* sets of ICs have actually  
2 been examined by the Court in this matter. Judge Sammartino reviewed the ICs  
3 for Papa John's and GrubHub, and determined that those were *sufficient*. [Doc.  
4 Nos. 55, 57]. Judge Stormes examined the ICs for OpenTable and Wanderspot  
5 and, applying a different standard, reached a different conclusion (although  
6 Best Western filed a joinder to OpenTable's and Wanderspot's motion, the Best  
7 Western ICs were not lodged with the Court). Despite this fact, defendants now  
8 misleadingly assert that Judge Stormes supposedly found that the ICs as to "all"  
9 defendants are deficient. That simply is not true. Neither Judge Stormes nor  
10 any other judicial officer has reviewed the IC's for the other defendants.

11 Any challenges to the sufficiency of the ICs by the seven defendants for  
12 which Ameranth does not propose serving amended ICs were time-barred by  
13 Judge Stormes' Chamber Rules (as well as by Judge Gallo's). Moreover,  
14 because the original defendants have all made at least some production of  
15 source code, the ICs Ameranth served on them all already contain citations to  
16 source code. (This would be without prejudice to Ameranth's right to  
17 *voluntarily* serve amended ICs to such defendants as permitted by the PLRs.)

## CONCLUSION

19 For the foregoing reasons, Ameranth respectfully requests the Court to  
20 adopt Ameranth's proposed schedule, whereby Ameranth would serve amended  
21 ICs conforming to the July 26 Order on all defendants in the in the  
22 consolidated cases other than Pizza Hut, QuikOrder, Seamless, Domino's,  
23 OWeb, Papa John's and GrubHub by November 21, 2013, so long as the  
24 defendants substantively respond to Ameranth's outstanding discovery,  
25 complete their "rolling productions" of responsive documents by September 6,  
26 respond substantively to Ameranth's interrogatories re source code  
27 organization, produce all PLR 3.4(a) materials and source code by September 6,

1 and produce the source code on review computers on which the appropriate  
2 software review and development tools have been installed. Alternatively, if  
3 the Court does not require defendants to make such productions prior to the date  
4 that Ameranth will serve amended ICs, Ameranth requests the Court to adopt a  
5 different specificity requirement for the “intermediary” ICs for such non-  
6 producing defendants consistent with that described in CSR v. Freescale and  
7 utilized in the Eastern District of Texas, with further amended ICs to be served  
8 for such defendants approximately 75 days after completion of their PLR 3.4(a)  
9 productions. Further, because of the importance of the issues presented, and the  
10 recent judicial reassignment of these multiple consolidated cases, Ameranth  
11 requests oral argument on this motion.

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## ***DEFENDANTS' POSITION***

## I. ISSUES TO BE DECIDED

1. What is the proper timing for Ameranth's ordered correction of its infringement contentions ("ICs")? ANSWER: Because Ameranth's ICs have been found legally deficient and it has been ordered to correct and supplement same in at least four specific ways, Defendants submit that Ameranth should be required to do so now and, in accordance with established precedent, Defendants' responsive discovery obligations should be extended or stayed until Ameranth complies with the order.
2. To which Defendants does Ameranth's ordered correction apply? ANSWER: Because Ameranth's ICs share common deficiencies as to all Defendants, Defendants submit that Ameranth is required to correct and supplement as to all Defendants.

## II. INTRODUCTION

Plaintiff Ameranth, Inc. and defendants OpenTable, Inc., Wanderspot, LLC and Best Western International, Inc. (“Moving Defendants”) filed a joint motion for determination of discovery dispute regarding the sufficiency of Ameranth’s ICs [Doc. No. 402] (Joint Motion”). Magistrate Judge Stormes granted Moving Defendants’ request that Ameranth be required to either amend four specific aspects of its ICs or drop those contentions. Order Determining Joint Motion for Discovery Dispute No. 2 and Granting Defendants’ Request that Ameranth Amend Its Infringement Contentions or Drop those Contentions [Doc. No. 432] (“Order 2”) at 1. Specifically, Judge Stormes found Ameranth’s ICs deficient in four separate respects:

1. Ameranth's contentions regarding doctrine of equivalents fail to comply with Patent L.R. 3-1(e);

2. Ameranth's contentions regarding contributory infringement fail to comply with Patent L.R. 3-1(d);
3. Ameranth's use of a single claim chart to contend that "all versions" of the accused systems infringe fails to comply with Patent L.R. 3-1(b) and (c);
4. Ameranth's contentions fail to identify with specificity where in the accused system the alleged infringement occurs and how the claim elements are met as required by Patent L.R. 3-1(c)

*See Order 2 at 10-14. Judge Stormes therefore ordered Ameranth to amend its contentions to correct the numerous deficiencies in its ICs (or else drop them):*

Ameranth must add facts and specify how accused systems of defendants OpenTable, Wanderspot and Best Western infringe the claims under the doctrine of equivalents, as well as address all previous accused versions and provide more specific claim charts, or else drop the contentions, by a date to be proposed by the parties.

*Id.* at 15. Recognizing that the deficiencies in the ICs were likely common as to many other defendants in these consolidated cases, Judge Stormes further ordered:

To the extent this order may implicate other sets of ICs, the parties shall meet and confer and by August 5, 2013, file a proposed joint schedule of service of the ICs subject to this order as well as any other ICs that may need to be amended, and shall notify the court of any other scheduling order dates that may need to be amended.”

*Id.* The parties met and conferred, but failed to reach an agreement regarding either the timing for the Court ordered amendment or the additional defendants for which Ameranth must serve amended ICs. Unable to reach agreement, those issues are presented to the Court for determination.

First, with respect to the timing of Ameranth’s amended ICs, Defendants propose that (a) Ameranth have until September 16 to serve amended ICs, for *all* Defendants, that comply with the Patent Local Rules (“PLRs”) in accordance

1 with Order 2, and (b) all other dates contained in the current February 22, 2013  
2 Scheduling Order [Doc. No. 346] and the Court's other orders of February 22,  
3 2013 [Doc. No. 345] and July 15, 2013 [Doc. No. 422] be advanced a similar  
4 amount of time as follows:

1. The Defendants' invalidity contentions and PLR 3.4(a) technical production would move from September 6 to October 7;
2. The deadline for Defendants to substantially complete their rolling production of documents responsive to certain of Ameranth's requests would move from September 6 to October 7;
3. The date to exchange claim terms, proposed constructions, and extrinsic evidence would move from September 26 to October 28;
4. The exchange of responsive claim constructions and extrinsic evidence would move from October 24 to November 22;
5. The date to file a joint claim construction chart and the other materials required by paragraph 7 of the February 22 order would move from November 21 to December 20;
6. Completion of claim construction discovery would move from December 19 to January 24;
7. Opening claim construction briefs would move from January 16 to February 21;
8. Responsive claim construction briefs would move from February 27 to March 28; and
9. The Markman hearing would be reset by the Court.

24 Ameranth argues because PLR 3.6(a) permits amendment of ICs until the  
25 filing of the parties' Joint Claim Construction Chart, it is not obligated to  
26 provide ICs that comply with the requirements of PLR 3.1 until that time<sup>1</sup>

<sup>27</sup> Ameranth previously stated that its proposal was to amend its ICs for all  
<sup>28</sup> Defendants other than Papa John's, Grub Hub, O-Web, Pizza Hut, QuikOrder,  
26

1 However, the fact that the PLRs contemplate a separate deadline for amendment  
 2 of ICs does not relieve Ameranth of its obligation to provide ICs that comply  
 3 with the PLRs in the first instance. Indeed, Judge Stormes has already rejected  
 4 this argument. Judge Stormes specifically held that “[i]n this court’s view the  
 5 questions of whether, how and when Ameranth should assert . . . theories in its  
 6 contentions are questions to be answered ***now, and not in the future.***” Order 2  
 7 at 7 (emphasis added). The Magistrate Judge’s determination is well supported  
 8 because, to find otherwise, would frustrate “[t]he purpose of local patent rules []  
 9 to streamline discovery and provide structure to discovery and enable the parties  
 10 to move efficiently toward claim construction and the eventual resolution of  
 11 their dispute.” *Id.* at 9 (citation and quotation omitted). As Judge Stormes  
 12 recognized, “Patent local rules are ‘designed specifically to require parties to  
 13 crystallize their theories of the case early in the litigation so as to prevent the  
 14 shifting sands approach to claim construction.’” Order 2 at 4 (quoting *O2 Micro*  
 15 *Int’l, Ltd. v. Monolithic Power Sys.*, 467 F.3d 1355, 1364 (Fed. Cir. 2006)).  
 16 Accordingly, the PLRs require that Ameranth crystallize its infringement  
 17 theories in ICs that comply with the PLRs, so that the parties can move  
 18 efficiently towards claim construction.

19 Ameranth further argues that it should not be required to provide ICs that  
 20 comply with the PLRs until Defendants have completed production of  
 21 documents under PLR 3-4(a). In addition to being irrelevant to Order 2,  
 22 Ameranth ignores that the PLRs contemplate that defendants’ PLR 3-4(a)  
 23 disclosure to occur ***after*** Plaintiffs have provided infringement contentions that  
 24 meet the requirements of PLR 3-1. See PLR 3-4 (requiring PLR 3-4(a)

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25  
 26 Seamless, and Domino’s. Ameranth now appears to be rejecting even its own  
 27 proposal and refusing to concede that Order 2 requires amendment as to any  
 28 Defendant other than the Moving Defendants. Effectively, Ameranth seeks to  
 force Defendants to file multiple discovery motions on common issues, but  
 require only a single motion for any issue it deems “common” to all Defendants.  
 27

1 document production along with Invalidity Contentions); PLR 3-3 (setting  
 2 deadline for invalidity contentions “not later than sixty (60) days” after service  
 3 of PLR 3-1 infringement contentions). And, for good reason. PLR 3-1  
 4 infringement contentions define the scope of document production required  
 5 under PLR 3-4(a). PLR 3-4(a) requires production of “documentation sufficient  
 6 to show the operation of any aspects or elements of any Accused Instrumentality  
 7 identified by the patent claimant in its PLR 3.1.c chart.” Without infringement  
 8 contentions that comply with the Patent Rules, Defendants cannot determine the  
 9 scope of document production required by PLR 3-4(a). In this regard, courts  
 10 have routinely extended or stayed a patent defendant’s discovery obligations  
 11 until the plaintiff meets its burden of providing infringement contentions  
 12 compliant with corresponding PLR 3-1 obligations. *See, e.g., Bender v. Maxim*  
 13 *Integrated Prods., Inc.*, 2010 WL 1135762 at \*2 (N.D. Cal. 2010) (“Until  
 14 plaintiff meets the burden of providing infringement contentions complaint with  
 15 PLR 3-1, the Court will not order defendant to processed with discovery.”); *see*  
 16 *also Implicit Networks Inc. v. Hewlett-Packard Co.*, No. 10-CV-03746 SI, 2011  
 17 WL 3954809, at \*4 (N.D. Cal. Sept. 7, 2011); *Infineon Techs. v. Volterra*  
 18 *Semiconductor*, No. C 11-6239 MMC (DMR), 2012 WL 4808445, at \*5 (N.D.  
 19 Cal. Oct. 9, 2012).

20 Second, with respect to the additional Defendants for which Ameranth  
 21 must serve amended ICs, Defendants submit that Ameranth must amend its ICs  
 22 as to *all* defendants or drop its contentions, because the deficiencies in  
 23 Ameranth’s ICs are common as to all Defendants. Despite Judge Stormes’s  
 24 determination that the same disclosures provided to both moving and non-  
 25 moving parties are inadequate, Ameranth once again argues that it (1) is not  
 26 obligated to amend its ICs until the PLR 3.6(a) deadline for amendment of ICs  
 27 and (2) has no obligation to provide amended ICs as to defendants that did not

move prior to the deadline to file a discovery challenges. Ameranth's position is misplaced because (1) the Court's February 22, 2013 scheduling order imposes an affirmative obligation to supplement its discovery responses in compliance with the Court's Order to provide ICs that comply with the local patent rules and the Court's February 22, 2013 Order and (2) Judge Stormes has already held that Ameranth's current disclosures are deficient and must be corrected.

### 7 | III. Argument

This Joint Submission responds to Judge Stormes’s order requiring the parties to meet and confer and “[1] file a proposed joint schedule of service of the ICs subject to this order,” [2] identify “any other ICs that may need to be amended, and [3] notify the court of any other scheduling order dates that may need to be amended.” Ameranth spends the vast majority of its brief not responding to Judge Stormes’ order, but instead arguing about discovery issues that are not before the Court and are not the subject of Order 2 and arguing for reconsideration of Order 2 without attempting to show that there is new evidence, a change in controlling authority, or clear error in the prior order that supports same.<sup>2</sup>

18 Ameranth seeks to circumvent not only the requirements of the PLRs, but  
19 also Judge Stormes's Order, explicitly requiring that Ameranth amend its  
20 contentions to comply with the PLRs. Judge Stormes found Ameranth's ICs

<sup>21</sup> Ameranth's arguments are based largely on authority that it elected not to  
<sup>22</sup> present in the first instance. Even if the Court were to engage in Ameranth's  
<sup>23</sup> request for reconsideration of Order 2 – which it should not – Ameranth's heavy  
<sup>24</sup> and new reliance on *Zest ID Holdings, LLC v. Implant Direct Mfg.*, LLC, 2013  
<sup>25</sup> WL 1626 III (S.D. Cal. April 15, 2013) [Dkt. No. 216] is misplaced. First, that  
<sup>26</sup> case did not involve Defendants challenging a plaintiff's ICs, but instead a  
<sup>27</sup> patentee's motion to amend ICs related to a dental implant device. Second, the  
<sup>28</sup> *Zest* court reviewed the patentee's proposed amended ICs and concluded that  
they presented "both specific and illustrative examples of the Defendants'  
infringement of the asserted claims, and identify each specific element as to  
which plaintiffs have a claim." In contrast, Judge Stormes independently  
concluded that Ameranth's ICs merely "attempt[] to identify the location of  
elements of the claim within the accused instrumentality," but does not explain  
'how' the accused systems practice the claimed elements. Order 2 at 14.  
29

1 failed to comply with the requirements of the PLRs. This was not a close  
2 question. As discussed above, Judge Stormes found that Ameranth's ICs were  
3 deficient in at least four distinct respects. *See* Order 2 at 10-14. Furthermore,  
4 Judge Stormes held that “[i]n this court’s view the questions of whether, how  
5 and when Ameranth should assert” its infringement theories “are questions to be  
6 answered now, and not in the future.” Order 2 at 7.

Ameranth contends that it should not be required to amend its ICs *in any respect* until (1) after it has received Defendants' PLR 3.4(a) technical document productions, which are currently due to be served on September 6, 2013, under the February 22, 2013 Scheduling Order, and (2) November 21, 2013, which is the current deadline for Ameranth to serve Amended ICs under PLR 3.6 and the February 22, 2013 Scheduling Order. In other words, while Judge Stormes found that Ameranth's ICs failed to meet the requirements of the PLRs, Ameranth effectively contends that that finding should have no effect. Instead, Ameranth argues that the case should proceed on its existing track, with Ameranth getting immediate access to discovery under PLR 3.4(a), and that despite the July 26 Order it will not provide the ICs contemplated by the PLRs and the February 22 Order until November 21.

19 Ameranth's attempt to circumvent the requirements of the PLRs and  
20 Judge Stormes's Order should be rejected for at least the following reasons.

21       A. Ameranth must first comply with the Patent Local Rules in  
22                   order to permit Defendants to satisfy their corresponding  
23                   obligations.

24 Ameranth's position is effectively that a plaintiff need not serve ICs that  
25 comply with PLR 3.1 until the deadline to amend ICs "as a matter of right"  
26 under PLR 3.6, which was the *same* position presented in the joint motion and

1 rejected by Order 2. *See* Joint Motion at 10.<sup>3</sup> Ameranth's position was  
 2 previously rejected and should be rejected again because it would frustrate the  
 3 PLRs' purpose of focusing discovery and narrowing issues for invalidity  
 4 contentions, Markman, summary judgment, trial, and beyond.

5 Infringement contentions that comply with PLR 3.1 are critical, as they  
 6 inform Defendants' invalidity contentions, frames the scope of proper discovery  
 7 and may result in the identification of additional invalidating prior art. In this  
 8 regard, the PLRs set forth a schedule of events "designed specifically to require  
 9 parties to crystallize their theories of the case early in the litigation so as to  
 10 prevent the shifting sands approach to claim construction." Order 2 at 4 (quoting  
 11 *O2 Micro Int'l, Ltd. v. Monolithic Power Sys.*, 467 F.3d 1355, 1364 (Fed. Cir.  
 12 2006)).

13 First, Patent Local Rule 3-1(a) requires that Plaintiffs serve ICs that "must  
 14 contain" information that complies with numerous requirements. PLR 3-1(a).  
 15 The purpose of these requirements is to "forc[e] an accusing party to  
 16 'crystallize' its infringement theories," so the opposing party is not 'forced to  
 17 guess'" which products allegedly infringe, or how they allegedly infringe.  
 18 Order 2 at 12-14 (internal citations omitted).

19 Only *after* Plaintiffs have provided ICs that meet the requirements of PLR  
 20 3-1, are Defendants required to provide invalidity contentions under PLR 3-3  
 21 and accompanying document productions under PLR 3-4. *See* PLRs 3-3, 3-4.  
 22 This makes sense, given that PLR 3-1 ICs define the scope of document  
 23 production required under PLR 3-4(a). An accused infringer's obligations under  
 24 PLR 3.4 to produce information "sufficient to show the operation of any aspects

---

25 <sup>3</sup> As moving Defendants originally explained in the joint motion, Ameranth  
 26 argues that the motion should be denied because Ameranth intends to exercise  
 27 its right to amend its ICs after receiving discovery from Defendants. "That  
 28 Ameranth is allowed to amend its PICs under recent amendments to the Patent  
 Local Rules does not, however, excuse Ameranth's obligation to provide timely  
 PICs that properly disclose its infringement theories." Joint Motion at 10.

1 or elements of any Accused Instrumentality identified by the patent claimant” is  
 2 necessarily preconditioned on a patent holder’s prior compliance with PLR 3.1.  
 3 An accused infringer should not be forced to guess what aspects or elements or  
 4 which versions of its products allegedly infringes an asserted patent. *Id.*  
 5 Ameranth’s proposal would do exactly that and encourage the service of  
 6 deficient ICs.

7 Similarly, the PLRs contemplate the exchange of both infringement and  
 8 invalidity contentions before the parties move forward into the claim  
 9 construction phase of the case. *See* PLR 4-1(a) (setting deadline for exchange of  
 10 preliminary claim constructions 14 days after service of invalidity contentions).

11 This schedule of exchanges promotes the purpose of the PLRs, forcing the  
 12 parties to “crystallize their theories of the case early in the litigation.” Order 2 at  
 13 4 (quoting *O2 Micro Int'l, Ltd. v. Monolithic Power Sys.*, 467 F.3d 1355, 1364  
 14 (Fed. Cir. 2006)). Ameranth’s position that it need not provide ICs until *after*  
 15 Defendants have served invalidity contentions and accompanying document  
 16 productions frustrates the purpose of the Rules. Indeed, Ameranth’s position  
 17 would encourage parties to intentionally serve deficient ICs with an eye toward  
 18 withholding important contentions and details to gain an improper reward in the  
 19 form of an tactical advantage achieved through the service of those deficient  
 20 ICs.

21 Based on the similarity of the Northern District of California’s PLRs, this  
 22 District has recognized Northern District decisions interpreting those Patent  
 23 Local Rules as persuasive authority. *See* Order 2 at 9-10. The Northern District  
 24 has already considered and rejected Ameranth’s arguments. Specifically,  
 25 recognizing that service of ICs that comply with the PLRs is a *necessary*  
 26 *predicate* to the service of defendants’ invalidity contentions and document  
 27 productions, courts in the Northern District have extended or stayed a patent

1 defendant’s discovery obligations until the plaintiff meets its burden of  
2 providing ICs compliant with that district’s PLR 3-1. *See, e.g., Bender*, 2010  
3 WL 1135762 at \*2 (“Until plaintiff meets the burden of providing infringement  
4 contentions complaint with PLR 3-1, the Court will not order defendant to  
5 processed with discovery.”); *see also Implicit Networks*, 2011 WL 3954809, at  
6 \*4; *Infineon Techs*, 2012 WL 4808445, at \*5.

7       B. Ameranth is not relieved of its obligations to provide  
8           infringement contentions that comply with the requirements of  
9           Patent Local Rule 3-1, simply because this case implicates  
10          software.

11 Ameranth's arguments that it requires access to Defendants' technical  
12 documents, including confidential source code, in order to prepare ICs that  
13 comply with PLR 3.1 misses the mark.

14 As an initial matter, Ameranth’s argument appears to be a red herring.  
15 First, Judge Stormes identified deficiencies in Ameranth’s ICs related to its  
16 doctrine of equivalents, contributory infringement, and accused “versions”  
17 contentions, none of which even arguably require access to Defendants’  
18 confidential source code. Second, with respect to at least one Defendant,  
19 OpenTable, Ameranth received both technical documentation and source code  
20 relating to the accused systems months before it served ICs that were subject of  
21 Judge Stormes’s Order. Order 2 at 14. Nevertheless, Judge Stormes found even  
22 these contentions failed to satisfy the requirements of the PLRs. *Id.*

23 Ameranth’s primary argument is that it is allegedly impossible to comply  
24 with the “reverse engineering or its equivalent” standard enunciated in Judge  
25 Stormes’s order *unless* it is first given access to Defendants’ confidential  
26 technical documents and source code. Order 2 at 14. However, in making this  
27 argument, Ameranth reads into the Order words that are not there. The Order

1 does not state that the *only* way to meet the required standard is through citation  
2 to source code. Rather, the Order merely explains that because Ameranth *had*  
3 *access* to OpenTable’s source code for several months before serving ICs, that  
4 information was “readily available” to Ameranth to cite in its ICs.

5        Although Ameranth did not have the confidential source code of the other  
6 Moving Defendants (Wanderspot and Best Western) before serving ICs, it was  
7 still obligated to use whatever information *was* available to “link the cited  
8 evidence to its claims” and “identify with specificity where in the accused  
9 system the alleged infringement occurs and how the claim elements are met.”  
10 Order 2 at 14; *see also Linex Techs. Inc. v. Belkin Int'l, Inc.*, 628 F. Supp. 2d  
11 703, 709 (E.D. Tex. 2008) (finding ICs deficient under E.D. Tex. Patent Rule 3-  
12 1 despite the fact that plaintiff did not yet have access to proprietary firmware or  
13 software, because “Plaintiff has failed to specifically delineate how the  
14 operation of any Accused Product corresponds to any claim limitation,” and  
15 “[t]his is a situation where there is publicly available information which, if  
16 utilized, would have provided more information to Defendants than Plaintiff’s  
17 ICs did in this case. Though this information may not have fully answered all of  
18 Defendants’ questions regarding the Infringement Contentions, such information  
19 would have provided more information than was initially disclosed.”).

In this regard, Ameranth wholly failed to review public information about the accused systems. For instance, Ameranth failed to review publicly available source code that it has had access to since before filing suit. Specifically, Ameranth has made numerous demands for the production of source code (and the manner in which it must be produced), but Ameranth does not cite to or quote a single line of the publicly available source code for any of the accused websites. For example, an Internet Explorer web browser rendering the html code received when searching for San Diego restaurants through Open Table

1 (<http://www.opentable.com/san-diego-restaurants?mn=57>) receives over 1300  
 2 lines of HTML code that can be viewed by simply clicking the “view” menu and  
 3 selecting “source.” Running a search for restaurants near “880 Front St #4290”  
 4 generates over an additional 1300 lines of code. And, of course, thousands of  
 5 additional lines of code are received as a user navigates through the steps  
 6 required to reserve a table.

7       Reviewing this publicly available code would, among other things, permit  
 8 Ameranth to identify with reasonable particularity, among other things: (1) data  
 9 and applications that are allegedly stored on a web page ('850 Patent, Claim 12,  
 10 element (b)); (2) what applications and data are allegedly synchronized to a web  
 11 page ('850 Patent, Claim 12); (3) what information entered on a web page is  
 12 allegedly automatically communicated to handheld device ('850 Patent, Claim  
 13 14); (4) what information entered on a handheld device is allegedly  
 14 automatically communicated to a web page ('850 Patent, Claim 15); and (5)  
 15 what hospitality application information is allegedly linked and synchronized  
 16 simultaneously to a web page ('077 Patent, Claim 13).

17       The PLRs do not permit plaintiffs to withhold disclosure of their theories  
 18 of “how the claim elements are met” until after the plaintiff is given access to  
 19 confidential source code, and Judge Stormes’s order does not endorse any such  
 20 perversion of the PLRs. In fact, Ameranth’s position is contrary to the plain  
 21 language of the PLRs which explicitly contemplate production of source code  
 22 sixty (60) days *after* service of compliant infringement contentions. *See* PLR 3-  
 23 4(a). Like all plaintiffs, Ameranth should be required to properly disclose its  
 24 theories *before* being given access to confidential source code, and then it  
 25 should supplement its ICs with pinpoint citations to the code after the PLR  
 26 3.4(a) production has been made. *See Big Baboon Corp. v. Dell, Inc.*, 723 F.  
 27 Supp. 2d 1224, 1228, (C.D. Cal. 2010) (Interpreting and applying N.D. Cal.

1 PLR 3-1, and stating that “Once source code has been provided to the plaintiffs,  
 2 however, courts have required plaintiffs to supplement their infringement  
 3 charges with pinpoint citations.”).

4 Ameranth’s arguments related to the inefficiencies of the potential need  
 5 for it to produce two sets of amended ICs ring hollow because the first set of  
 6 amendments is required by its own failure to comply with the PLR  
 7 requirements. Ameranth should not be rewarded and Defendants should not be  
 8 penalized for Ameranth’s non-compliance. Defendants are both entitled to and  
 9 require compliant ICs from Ameranth to satisfy their corresponding PLR  
 10 requirements and other discovery obligations.

#### 11 **IV. Ameranth is required to supplement its ICs to all Defendants.**

12 Judge Stormes ordered “[t]o the extent this order may implicate other sets  
 13 of ICs, the parties shall meet and confer and by August 5, 2013, file a proposed  
 14 joint schedule of service of the ICs subject to this order as well as any other ICs  
 15 that may need to be amended.” Order 2 at 15. Ameranth does not and cannot  
 16 reasonably dispute that Order 2 implicates the ICs of all Defendants. Indeed, the  
 17 deficiencies identified in Magistrate Judge Stormes’s Order are ubiquitous  
 18 among the ICs served on all the Defendants. Instead, it argues that it is not  
 19 obligated to amend its ICs as to certain Defendants that did not challenge its ICs  
 20 within the time period prescribed by Judge Stormes’s Chamber Rules.<sup>4</sup>

21 First, Ameranth’s argument ignores Magistrate Judge Stormes’s order that  
 22 the Parties meet and confer to identify other ICs that Plaintiff may need to  
 23 amend in light of the directives contained in the order. Second, Ameranth’s

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24  
 25 <sup>4</sup> Ameranth simply ignored the requirements of the PLR 3.4 with deficient ICs  
 26 and now seeks to play “gotcha” by invoking the 45 day rule when Ameranth  
 27 itself was uncertain whether this rule applied to infringement contentions. (May  
 28 9, 2012 e-mail from Caldarelli to defendants stating: “In order not to run into  
      any issues with the Court’s 45 day deadline in its Chamber Rules (which may or  
      may not be applicable to the source code productions and PLR 3.4(a)  
      obligations) (emphasis added.).

1 argument that it has no duty to amend its deficient ICs ignores its obligation to  
2 “supplement or correct its disclosure or response” “in a timely manner if the  
3 party learns that in some material respect the disclosure or response is  
4 incomplete or incorrect, and if the additional or corrective information has not  
5 otherwise been made known to the other parties during the discovery process or  
6 in writing.” FED. R. CIV. P. 26(e). Furthermore, Ameranth ignores that the  
7 Court’s February 22, 2013, Scheduling Order imposes an affirmative obligation  
8 to supplement its discovery responses in compliance with the Court’s Order to  
9 provide ICs that comply with the local patent rules and the Court’s February 22,  
10 2013, Order.

In addition to the fact that it is contrary to both Judge Stormes’s order and the Federal Rules, Ameranth’s argument should be rejected because it is another effort to complicate this already overly complicated consolidation action. There is no reasoned basis to put Defendants on two separate tracks for disclosure obligations. Indeed, this would be contrary to the Court’s prior order that consolidated these proceedings for efficiency reasons and scheduled all Defendants’ disclosure obligations on a common date.<sup>5</sup>

18 | / / /

19 | //

20 | / / /

<sup>5</sup> Ameranth's accusation that Defendants' proposals are not made in good faith is not well taken. Judge Stormes ordered Ameranth to amend its ICs and the parties to submit a proposed schedule, including changes to the Scheduling Order. Ameranth effectively refused to do so and now asks this Court to revisit Order 2 and adopt an approach rejected by Judge Stormes.

## V. Conclusion

Because the deficiencies in Ameranth's ICs are common as to all Defendants, Ameranth must amend its ICs as to all defendants within 30 days or drop its contentions as required by Order 2. As recognized by persuasive authority, Defendant's discovery obligations should be stayed or extended until Ameranth meets its burden of providing infringement contentions compliant with corresponding PLR 3-1 obligations.

Respectfully submitted,

Dated: August 15, 2013 CALDARELLI HEJMANOWSKI & PAGE LLP

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By: /s/ Richard Zembek

Richard Zembek

## **Liaison Attorneys for Defendants**

## SIGNATURE CERTIFICATION

Pursuant to Section 2(f)(4) of the Electronic Case Filing Administrative Policies and Procedures Manual, I hereby certify that the content of this document is acceptable to Richard Zembek, Liaison Counsel for Defendants, and that I have obtained Mr. Zembek's authorization to affix his electronic signature to this document.

/s/ William J. Caldarelli

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William J. Caldarelli